

No. 15,328

In the

United States Court of Appeals

For the Ninth Circuit

RALPH F. STALLMAN,

Appellant,

v.

CASEY BEARING COMPANY, INC., a corporation;
and T. W. CROSBY,

Appellees.

Brief for Appellees

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STATEMENT OF THE CASE

Appellant's Complaint (Tr. Vol. I, pp. 3-6) originally charged the Appellees named above and McGill Manufacturing Co., with infringement of the Stallman patent 2,334,227, of Nov. 16, 1943, for a Needle Bearing (Tr. Vol. II, p. 286). The action was dismissed on motion as to McGill Manufacturing Co., by order of August 9, 1954. Appellees denied (Tr. Vol. I, pp. 6-11) both validity and infringement of the patent. Appellant demanded a jury trial and the case was so tried before the Honorable Louis J. Goodman, Judge of the District Court.

At the conclusion of the evidence, Appellees moved for a directed verdict in their favor on the ground that the

claims of the patent in suit were invalid as a matter of law (Tr. Vol. I, pp. 263-4). That motion was denied (Tr. Vol. I, p. 264). The jury returned a verdict that the patent in suit was valid and infringed by Appellees as to Claims 3, 4, 5 and 9 (Tr. Vol. I, p. 13 and 279) and Judgment was entered thereon (Tr. Vol. I, p. 14).

Appellees then moved for judgment notwithstanding the verdict and for a new trial (Tr. Vol. I, pp. 15-26). The District Court rendered an Opinion Upon Motion for Judgment Notwithstanding Verdict (Tr. Vol. I, pp. 27-34) and entered a Judgment granting the motion for judgment n.o.v., setting aside the verdict and judgment entered thereon (Tr. Vol. I, pp. 34-35).

THE SOLE QUESTION PRESENTED BY THIS APPEAL IS WHETHER THE DISTRICT COURT ACTION WAS COR- RECT

The only question presented by this Appeal is whether the District Court acted correctly in granting Appellee's Motion for Judgment Notwithstanding the Verdict.

It is quite clear that in this case the District Court acted in strict accordance with the rules which, in patent cases as in any other, is deemed well settled and hence there was no impropriety in the action taken.

SUMMARY OF THE ARGUMENT

1. There Was No Impropriety in the Granting of Appellee's Motion For Judgment Notwithstanding the Verdict.
2. The Prior Art Clearly Demonstrates The Correctness of the Trial Court's Judgment.
3. The Claims of the Patent in Suit Do Not Measure the Invention as Patented or as Presently Claimed by Appellant.

4. The Perception or Recognition of New Advantages in Old Structures Does Not Rise to the Dignity of Invention.

5. McGill is Not a Party to the Action.

6. Conclusion.

THERE WAS NO IMPROPRIETY IN THE GRANTING OF APPELLEE'S MOTION FOR JUDGMENT NOTWITHSTANDING THE VERDICT

It is argued by Appellant (Brief pp. 16-18) that upon the record, as a whole, "there was sufficient evidence to raise a question of fact as to whether the Stallman patent performed a new and useful function by a *combination of these elements known in the prior art*". It is not clear whether by "a combination of these elements" appellant is alluding to the combination of elements shown and described in the Stallman patent or whether the reference is to Appellant's present conception of what the Stallman patent was intended to speak about but did not. In either event any fair appraisal of the prior art patents, such as will follow herein, reveals that in granting the Appellee's motion for judgment n.o.v. the District Court was simply performing its duty so clearly spelled out in the decisions of this Court in cases where the claimed invention does not meet the rules and standards established to determine the presence or absence of invention.

This Court, on at least two different occasions, (i.e., in *Himes v. Chadwick*, 199 F(2d) 100, 95 USPQ 59 and *Berkeley Pump Co. v. Jacuzzi Bros., Inc.*, 214 F(2d) 785, 102 USPQ 100, 105) has seen fit to embrace the rule of *Packwood v. Briggs & Stratton Corp.*, 3 Cir., 195 F(2d) 971, 973, 93 USPQ 274, concerning the right and duty of the trial judge to appropriately deal with situations where the circumstances indicate that the jury has departed or could de-

part from “the relevant criteria by which either a jury or judge must be guided in their *fact-finding function*”.

The rule was succinctly stated in the *Packwood* case as follows (93 USPQ 275):

“This finding of invention and validity was very clearly wrong. A jury in a patent case is not free to treat invention as a concept broad enough to include whatever discovery or novelty may impress the jurors favorably. Over the years the courts of the United States and particularly the Supreme Court, have found meaning implicit in the scheme and purpose of the patent laws which aids in the construction of their general language. In this process, rules and standards have been developed, for use as guides to the systematic and orderly definition and application of such a conception as invention in accordance with what the courts understand to be the true meaning of the Constitution and the patent laws. Once such standards and rules are authoritatively announced any finding of ‘invention’ whether by a court or a jury must be consistent with them.”

There the jury had brought in a verdict that plaintiff’s patent was “valid as to lawn mowers only”. The trial judge, while candidly stating his own conviction that the patent was invalid for lack of invention, denied a motion for judgment n.o.v., upon the reasoning that “he had no authority to substitute his judgment on the contested issue of invention for that of the jury”. The Court of Appeals reversed with the observation (93 USPQ 276):

“In the instant case the district court should have entered judgment n.o.v. upon the basis of a ruling that, consistent with controlling standards, the device in suit plainly could not embody invention.”

In the *Himes* case, *supra*, this Court adopted the rule of the *Packwood* case and observed it as “well expressed” (95 USPQ 60). There this Court affirmed a judgment n.o.v. because its examination of the record convinced it that it was an appropriate case for the exercise of the powers of the trial judge as defined in the *Packwood* decision. It summarized its conclusions in this manner:

“Measured by these standards and by the rules generally announced by the Supreme Court as tests for invention, we think that so far as the Parks patent is concerned, this is a clear-cut case of lack of invention and that under the rule we have stated above as to its claims it was the duty of the court to enter a judgment n.o.v.”

Of like import was the holding of this Court in the *Berkeley Pump* decision, *supra*. There the Court affirmed the trial court’s judgment for a directed verdict being convinced that it represented an appropriate exercise of “the power of a trial court over a jury verdict in patent cases”.

Absent this rule, jury verdicts, such as the one in the instant, could lead to ludicrous results. Upon the one hand we would have standards and rules announced for the testing of invention by the courts and upon the other juries would be free to “treat invention as a concept broad enough to include whatever discovery or novelty may impress the jurors favorably” (Cf. the *Packwood* decision (93 USPQ 275)). Such a double standard has no place in American jurisprudence.

The decision of this Court in *Hansen v. Safeway Stores, Inc.* 238 F(2d) 336, does not aid appellant. In the first place that case involved unusual facts and proceedings clearly distinguishing it from the case at bar. There the jury disagreed and was discharged, leaving unresolved disputed

questions of fact relative to validity of the patent in suit. The Trial Court entertained and granted a motion for a directed verdict, notwithstanding the existence of “two propositions of fact”, namely, (1) a strong presumption of validity of the patent created by appellate action of the Court of Customs and Patent Appeals and (2) “there was no evidence of prior art or anticipation sufficient to take the case out of the province of the jury”.

Neither of these propositions appears in the instant case. Here the asserted invention had never met the appellate test of the Patent Office tribunals or the Court of Customs and Patent Appeals and, in fact, the presumption of validity was substantially impaired, if not destroyed, by prior art not referred to by the Patent Office. Validity is likewise destroyed by Appellant’s obvious failure to comply with 35 U.S.C. 112 in the absence of a written description or claims pointing out and distinctly claiming the subject matter which Appellant now regards as his invention (as to which more will be said elsewhere in this brief under an appropriate heading). Furthermore, here there was *abundant* evidence of prior art or anticipation sufficient to take the case out of the province of the jury, as the District Court held.

It is of the utmost significance that this Court, in deciding the *Hansen* case as it did, reiterated the rule that it laid down in the earlier case of *Himes v. Chadwick*, 199 F(2d) 100, 95 USPQ 59, by saying (page 172 of 110 USPQ).

“It is perfectly true that, even if a jury has found a patent to be valid, the trial court can set aside the finding and enter a judgment for defendant, *if there are no grounds for the verdict.*” (Emphasis supplied.)

But Appellant would have it believed that some other and different rule applies, placing a halo around the jury’s ver-

dict in every patent case regardless of the facts and circumstances. Appellee does not understand that to be the law and it is believed clear from the record that the judgment appealed from was fully justified and proper.

THE PRIOR ART CLEARLY DEMONSTRATES THE CORRECTNESS OF THE TRIAL COURT'S JUDGMENT

The prior art patents so straitjacketed the Stallman patent by anticipation as to oblige Appellant to adopt a version of the invention wholly different from that set forth in the specification and claims. Elsewhere in this brief we have dealt with the fact that Appellant's current version of the invention was not disclosed or claimed and therefore the patent is invalid for failure to comply with the patent statutes. There will be no need to dwell on that proposition at this point of the brief. But it is manifest that taken either in the light of the patent disclosures or Appellant's present version, the Stallman concept did not meet the standard of invention and, moreover, was anticipated.

We turn now to a consideration of the prior art patent in chronological order.

A. The Kempster Patent (585,580)

It should first be noted that this patent was *not* cited by the Patent Office during prosecution of the Stallman patent application.

Kempster 585,580 (See copy Tr. Vol. II p. 294) indicates that the bearing art had progressed substantially, if not entirely, to the point of Stallman's claimed invention as early as the year 1897. It shows and describes an Anti-friction Journal Bearing having an outer bushing or casing 2 with interior circular track surfaces 3 (which are the outer races of the bearings as in the case of Stallman's outer

race 10) separated by a narrow projecting annular rib 4. The bushing or casing 2 is provided with means, such as the outer flange 5, for securing it to wooden sheaves or wheels by suitable screws.

Anti-friction rollers 6 are distributed entirely around the interior of the bushing or casing 2, each roll having an annular groove 7 about its center "of sufficient width to loosely receive the annular projecting rib 4". The annular grooves 7 are additionally described as:

"* * being preferably of greater depth than said rib, so the smaller diameter of the rolls will not bear upon the top surface of the rib * *'" (Tr. Vol. II, 295, Col. 2, lines 76-78)

In this Kempster version of a bearing the journal 8 serves as the inner race for the rollers 6 (just as Stallman utilizes 11 as an inner race or would employ a shaft in lieu of the inner race 11).

To this point Kempster was foreshadowing Appellant to at least the extent of the devices shown in Figs. 1 and 4 of the Stallman patent, since the description of the Kempster parts and their relationship aptly fits the devices illustrated in those illustrations and there would be no substantial, perceivable difference in function. All that is missing is the Appellant's current theory of the operation of his device, namely, that the guide ring or rail (the rib 4 of Kempster) should be placed on the stationary race or member of the bearing to permit correction of the skewing action of the rollers. But that version of Stallman is neither disclosed nor claimed in the patent in suit and, at best, represents Stallman's present perception of how the device should work.

To this basically described structure Kempster added his antifriction disks 9 which were placed between the rolls 6.

The disks were slightly thinner than the central groove 7 in the rolls 6 "so as to fit loosely therein" and roll upon the smaller diameter of the rolls 6 (as defined by the grooves 7) and upon the top surface of the annular rib 4. As the trial court correctly observed (Tr. Vol. I, p. 31) it is apparent that these separators or antifriction disks 9 would not be necessary to the operation of the bearing described. This much is obvious from a consideration of the operability of the basic Kempster structure above-described and the fact that the specification of Kempster 747,324 states such separators may be entirely dispensed with, if so desired (Tr. Vol. II 309, l. 87-91), as the District Court noted (Tr. Vol. I, p. 31, footnote).

Beyond this Kempster even anticipated Stallman's use of a split ring 16 to keep the rollers 12 in place when the inner race 11 was removed. Kempster shows a split ring 10 for the purpose of holding the rollers 6 in place and prevent the bearing from falling apart during shipment (Tr. Vol. II, p. 296, l. 3-32).

Obviously, upon removal or omission of the separator disks 9, the Kempster device would function precisely as Stallman's device when the latter is viewed in the light of the patent disclosure, since the loose fit of the parts would permit misalignment of the rollers 6 under uneven load distribution and realignment when the shoulder defined by the groove 7 bore against the rib 4. Moreover, the parts could be re-dimensioned as desired within the skill of the calling and this would not involve invention.

B. The Kempster Patent 747,324

This patent (see copy Tr. Vol. II, p. 308) teaches that, if desired, the guide rib or rail 8 may be formed as an integral part of the inner race 4 and project outwardly there-

from into the annular groove 2 of the rollers 1. (Tr. Vol. II, p. 310, 1. 35-39). Obviously when such a bearing is fitted onto a shaft or axle, as is the case of a pulley or wheel, the inner race 4 would be *stationary* and the outer race 5-6 would rotate, precisely as in the device of Stallman's patent Fig. 2 (Tr. Vol. II, p. 286).

True enough this patent also shows a second guide rib, in the form of a ring 9 "separate from the outer bushing (5-6) and entering an annular groove formed at the meeting edges of the sections 5 and 6" of the outer bushing, and projecting into the grooves 2 of the rollers 1. When thus locked in place there are two guide ribs, i.e., inner 8 and outer 9. That structure satisfies the brief description given at page 15 of Appellant's Opening Brief.

But had Appellant read this Kempster patent further it would have been observed that in another form (Figs. 4 and 5), Kempster provided that the: (Tr. Vol. II, p. 310 lines 50-58)

"* * or said ring 9a may be made with a diameter a little less than the inner diameter of the sections 5 and 6 of the outer bushing *and be free to rotate within said outer casing*, if so desired, but in no case allowing said ring to move from a position where its surface will be other than concentric with the track on the outer bushing for the rolls." (Emphasis supplied.)

A comparison of that structure with Fig. 2 of the Stallman patent (Tr. Vol. II, p. 286) will reveal that, in both instances, the guide ribs 8 and 15 on the respective inner races are used as the primary guide means and that the only difference between the structures lies in the relative dimensioning of the rings 9a and 16.

It clearly appears, therefore, that the trial court was correct in viewing Kempster patent 747,324 as showing the

central guide rib on the inner race (Tr. Vol. I, p. 33) since the free ring 9a would not be the primary guide rib and the guiding effect it might have would be negligible in the same sense that Stallman's keeper ring 16 would act as a guide rib.

Kempster patent 747,324 therefore spells out anticipation of the invention set forth in the patent in suit as well as Appellant's more recent version of his invention.

C. The Zahn British Patent No. 17,841

Next in the order of chronology, attention is turned to the British patent to Zahn, dated August 8, 1906, which will be found at Tr. Vol. II, p. 292. It is there identified as "Haddan's Complete Specification", Reginald Haddan having been the Patent Agent to whom Zahn communicated the invention (Tr. Vol. II, p. 292, lines 1-5).

The Zahn patent is important because it completely negates Appellant's present theory that he was the first to recognize or perceive that, instead of trying to hold the rollers against the skewing force and misalignment, the rollers could be permitted to skew under the unbalancing forces until the shoulder of the reduced portion nearer the advanced side of the roller engages the stationary projecting ring or rail and to then utilize the "skewing force" to retard the advanced side of the roller until the other or trailing side of the roller advances sufficiently to straighten the position of the roller and thus disengage the shoulder from the stationary projection or rail (Appellant's Opening Brief, p. 6).

Zahn illustrated and described this principle and even went so far as to provide a bearing structure utilizing that principle. The illustration of the principle is found in Fig. 1 of the Zahn patent drawings and the description of that illustration is clearly and explicitly set forth in Page 1 of Zahn's complete specifications, lines 19-34. It need not be

repeated here, but suffice it to say that Zahn clearly teaches that when misalignment occurs and one end of the roller advances in relation to the other, frictional engagement of the roller with other components of the bearing can be utilized to right or straighten out the roller.

Zahn applied that principle to structure basically like the structures of the Stallman patent. It will be noted that Figures 2 and 3 of Zahn are described as the application of the righting principle to vehicle or other bearings where the inner journal member *b* is fixed (or stationary) and the outer bearing member *c* rotates (Zahn patent p. 1, lines 40-42). Thus the guide rail *g* is "fastened or formed" on the stationary bearing member *b*, just as Stallman now insists that his central guide rib or rail must be positioned or placed on his stationary bearing member.

In the bearing of Zahn's Figs. 4 and 5 the inner journal member *b* rotates, and the track ring *g* assembly is secured to that member, while in Fig. 6 the track ring *g* acting to engage and retard the advanced end of the roller, is on the outside stationary member *c*. In other words, Zahn recognized and applied his principle, as explained for Fig. 1, to a roller bearing with the guide rail on the stationary member as well as to a rotating member, thus teaching that, as early as the year 1906, the matter of placement of the guide rail was optional. It was a matter of "preference", depending upon the ultimate bearing installation and use.

In like vein Appellee's Vice-President Hoffman (Tr. Vol. I, pp. 123-132) testified to successful operation of the "Guiderol" bearing whether the guide rail or track ring was on the rotating race, or the stationary race, and that the customer was not concerned in any way with this condition alone.

While the District Court did not rely on this patent for its judgment, nevertheless it has anticipatory value and

may be considered by this Court, especially since it was *not* cited by the Patent Office.

D. The Heim Patent

The Heim patent is also significant since it clearly illustrates a structure wherein the outer raceway has an inwardly projecting central guide ring, rib or rail (Figs. 3, 4 and 5) entering a reduced neck portion formed by the groove 15 in rollers 14. The shaft 17 serves as the inner race. Figs. 1 and 2 show the outer race or member 10 as the hub of a wheel, but that form is described as an example. (Tr. Vol. II, p. 303, lines 37-40). Heim does not, however, disclaim operability of his device in situations where the outer member 12 carrying the central guide rib would be stationary and the shaft 17 would be the rotatable member and it is obvious that it could so operate.

About the only distinction that Appellant draws between the Stallman device and the Heim structure is the asserted relative tightness of fit of the parts, as indicating that the purpose of Heim was to hold the rollers without any play (Opening Brief p. 13-14), but, as we have seen from a study of the other prior art patents, there was no novelty in making these bearing devices with loosely fitting parts if desired and one would be equally free to do so in uses of the Heim structure. In fact, any skilled bearing man would be expected to gauge the tolerances according to the need.

This examination of the prior art patents leads inescapably to the conclusion that Stallman merely utilized and put together devices well known in the bearing art. The devices he assembled each had well known separate functions and they were assembled for the mere sum or aggregate of those functions. Stated otherwise, the devices in the aggregation did not functionally operate differently than before.

This Court, in *Jacuzzi Bros. Inc. v. Berkeley Pump Co.*, 191 F(2d) 632, 91 USPQ 24, 29 (CA 9) laid down the following rule respecting such combining of devices well known in the art:

“* * * there is no invention in the placing together of devices well known in the art, however novel and useful may be the results, unless a functional difference from all previously known constructions be achieved. *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549, 550.”

See also *A & P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 152, where it was said:

“The standard of patentability is a constitutional standard; *and the question of validity of a patent is a question of law.* *Mahn v. Harwood*, 112 U.S. 354, 358. The Court fashioned in *Graver Mfg. Co. v. Linde Co.*, 336 U.S. 271, 275, a rule for patent cases to the effect that this Court will not disturb a finding of invention made by two lower courts, in absence of a very obvious and exceptional showing of error. That rule, imported from other fields, never had a place in patent law. Having served its purpose in *Graver Mfg. Co. v. Linde Co.*, it is now in substance rejected. The Court now recognizes what has long been apparent in our cases: that it is the ‘standard of invention’ that controls. That is present in every case where the validity of a patent is in issue. It is that question which the Court must decide. No ‘finding of fact’ can be a substitute for it in any case. The question of invention goes back to the constitutional standard in every case. We speak with final authority on that constitutional issue as we do on many others.” (Emphasis supplied.)

When considered in this light, it is perfectly obvious why the District Court was persuaded that the only reasonable

conclusion that could be drawn was that the patent is invalid. Any other conclusion would have required a total disregard for the established tests for invention.

THE CLAIMS OF THE PATENT IN SUIT DO NOT "MEASURE THE INVENTION" AS PATENTED OR AS PRESENTLY CLAIMED BY APPELLANT.

It is not without significance that Appellant's Opening Brief does not face up squarely to the proposition that, in considering the question of the validity of the Stallman patent, it is the claims of the patent that must be examined. The claims here relied on (3, 4, 5 and 9) do not distinguish from the prior art. Therefore Appellant's argument is predicated on the assumption that the Court should ignore the patent and consider the Stallman concept as though it were some common law right rather than a creature of the statute.

The basic rule for considering patent rights has been well stated in *Walker On Patents*, (Deller's Edition), Vol. II, page 770, as follows:

"It is the claims of a patent which 'measure the invention,' and which 'apprise the public of what is still left open to them.' (Paper Bag Pat. Case, 210 U.S. 405, 409; U.S.L. & H. Corp. v. Safety Car H. & L. Co., 261 Fed. 915, 918, C.C.A. 2; Fulton Co. v. Powers Reg. Co., 263 Fed. 578 580, C. C. A. 2; Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U.S. 502, 61 L. Ed. 871, 876.) A claim is not 'like a nose of wax which may be turned and twisted in any direction,' so as to make it include something more than, or something different from, what its words express, by merely referring to the specification. The claims are the creature of statute in which the inventor is required to particularly point out and distinctly claim his invention. (White v. Dunbar, 119 U.S. 47, 51.)"

Appellant states at Page 6 of the Opening Brief that the Stallman patent is simple and is well defined, for instance in Claim 5 of the patent, which is quoted. The brief then progresses to a current version of the Stallman invention or basic concept. But nowhere does Appellant point out in his Brief that the claims of the patent in suit allude or refer to the idea of permitting the rollers to skew under the unbalancing forces until the shoulder of the reduced portion nearer the advanced side of the roller engages the stationary projecting ring or rail, or that the "skewing force" is utilized to retard the advanced side of the roller until the other or trailing side of the roller advances sufficiently to straighten the position of the roller and thus disengage the shoulder from the stationary projection or rail. Nor does Appellant point out that the claims set forth that this action is repeated over and over again during an unbalanced condition of the bearing or why it performs with materially less friction than the devices which are trying to hold the rollers spaced or aligned constantly against the skewing forces, as set forth at Page 6 of Appellant's Opening Brief. The reason is quite clear. This so-called basic concept is not spelled out or defined in any of the claims of the Stallman patent.

Thus, as said elsewhere in this Brief, the claims fail to comply with the Statute (35 U.S.C. §112) requiring that they particularly point out and distinctly claim the subject matter which the patentee regards as his invention. Instead the claims, including Claim 5 used as an example in Appellant's Opening Brief, are broader than and different from the presently asserted invention of Stallman and are equally descriptive of bearings conforming to the prior art.

Since the claims in suit are relatively brief, we have set them forth below in their entirety with appropriate comparison with the prior art.

STALLMAN CLAIM 3

PRIOR ART

- | | |
|---|--|
| A bearing comprising | <i>Heim 1,885,914</i> |
| (a) a rotatable inner race and | Shaft 17; Fig. 1
(whether it is stationary or rotating is purely optional) |
| (b) a relatively stationary outer race | Element 12; Fig. 3
(optional as to its being stationary or rotating) |
| (c) rollers interposed between said races and having aligned reduced portions intermediate their ends, | Rollers 14 |
| (d) a ring carried by the outer race and projecting into the reduced portions of the rollers to prevent their longitudinal movement and | Ring 16'; Figs. 1, 2 and 3. |
| (e) a second ring registering with and permanently contained within said reduced portions to hold the rollers in position in the outer race when the inner race is removed. | Ring 16'; Fig. 3
(the dimensions of this ring and whether this ring is permanent or ejected are purely optional characteristics (Tr. Vol. II, p. 304, lines 68-83)) |

As the prior art clearly demonstrated, it is purely optional which bearing race remains stationary and which rotates. It depends upon the particular use and therefore is a matter of choice. This much is impliedly conceded by Stallman in his patent when he merely states a *preference* for the stationary member in the placement of his central guide rib, without explaining why this is so. In fact, the two words of *preference* (Tr. Vol. II, page 288, column 1, lines 26-31) comprise the only support to which Appellant can point for his present contention of invention.

The same may be said with respect to whether the keeper ring 16, is permanently contained, as in Rydbeck (Tr. Vol. II, p. 300) or ejectably contained, as in Heim (Tr. Vol. II, p. 302). That characteristic is not a patentable one.

STALLMAN CLAIM 4

KEMPSTER 747, 324 (Fig. 4)

A bearing comprising

- | | |
|---|---|
| (a) A revolving race and | The casing or element 5-6. |
| (b) A relatively stationary race, | Inner race or bushing 4. |
| (c) A plurality of rolls interposed between said races, | Rolls 1. |
| (d) And means carried by the stationary race only and engagable with the rolls intermediate their ends in the event they become misaligned with their normal positions. | The central guide rib or rail 8 projecting into the grooves 2 of the rolls 1. |

As hereinabove noted central guide rib 8 is the primary means "engagable with the rolls intermediate their ends in the event they become misaligned with their normal position". The fact that Kempster teaches a second ring 9a may be added does not detract from the anticipatory value of the prior patent, especially in view of the fact that its guiding effect would be negligible, if not questionable.

STALLMAN CLAIM 5

KEMPSTER 747, 324 (Fig. 4)

A bearing comprising

- | | |
|---|---------------|
| (a) a revolving race and | Elements 5-6 |
| (b) a relatively stationary race, | Element 4 |
| (c) a plurality of rolls interposed between said races and, | Rolls 1 |
| (d) having reduced portions intermediate their ends, | The grooves 2 |

- (e) means carried by the stationary race only and projecting into the reduced portions of the rolls to engage shoulders formed by said reduced portions in the event of misalignment of the rolls. Central guide rib 8

As stated in connection with claim 4, the presence or absence of Kempster's secondary ring 9a is of no moment since its guiding effect is negligible, if not questionable. Moreover, it (9a) could serve the same function as the retainer ring 16 of Stallman serves in his structure of Fig. 1 or Fig. 2.

STALLMAN CLAIM 9

KEMPSTER 585, 580

- A bearing comprising
- (a) a cylindrical inner race Shaft 8
and
 - (b) an outer race, 3 on 2
 - (c) a plurality of rolls having reduced portions intermediate their ends interposed between said races, Rollers 6 with grooves 7
 - (d) a ring carried by the outer race and registering within the reduced portions of the rolls to engage the rolls in the event they become misaligned with their normal position and Ring 4
 - (e) a second ring contained by said reduced portions of the rolls adjacent the inner race to retain the rolls in place against the outer race when the races are separated. Ring 10

If the word "contained" as here used is to denote permanent presence, it makes no difference, patentwise, whether the ring stays in or is ejected since its stated function is to hold the rollers in place when the inner race is separated from the outer race and roller assembly. Kempster 585,580 (not cited by the Patent Office), teaches that much. See keeper ring 10 (Tr. Vol. II, p. 294), Figs. 2, 3, 9 and 10 and the description thereof (Tr. Vol. II, p. 296, lines 3-32). See also Rydbeck (Tr. Vol. II, p. 300, ring 6).

The above comparison of the prior art could be extended, as there are other examples of the aptness of the description of the Stallman claims to prior art devices, but there appears to be no need to do so. The foregoing is believed adequate to demonstrate that this art is so crowded as to leave no room for the assertion of a claim to invention in the sense of the Stallman claims 3, 4, 5 and 9 and certainly not in the sense of Appellant's presently claimed version of his concept.

In addition, the applicability of the principles so clearly laid down in *Winslow Engineering Company v. LeRoy R. Smith*, 223 F(2d) 438, 106 USPQ 209, a case decided by this Court, will be readily apparent. There the Court felt compelled to hold the Winslow claims invalid for failure to comply with the statute and stated that it did not feel free to resort to the specification in an effort to draw therefrom limitations to save the claims. Here, as we have elsewhere stated, Stallman is in a less favorable position than was Winslow, because Stallman's specification is equally lacking in the requisite degree of particularization and, hence, there is nothing from which to draw any saving limitations.

While the foregoing fully answers the contentions set forth in Appellant's Opening Brief, it is believed fitting

to specifically comment on pages 4, 6 and 12 thereof wherein attempt is made to re-define the Stallman concept. Appellant has shown no new and unobvious function or result that his device has over the prior art even when the latest version of it is considered. The grooved rollers of Kempster, Heim and Zahn, straddling a guide rail, rib or ring as they do, will of necessity engage the same when there is misalignment of one of such grooved rollers. The amount of misalignment of the rollers held between the two races on top and bottom and engagement of the groove wall with the rail, will be limited. But if the spacing of the rollers between the two race rings, spacing between the roller grooves and corresponding rails or ribs and the permitted degree of skewing was important and significant, then the patent itself *must* define these dimensions and conditions (35 U.S.C. §112). Since Stallman's patent has no such description the claims are invalid for insufficiency of disclosure.

**THE PERCEPTION OR RECOGNITION OF NEW ADVANTAGES
IN OLD STRUCTURES DOES NOT RISE TO THE DIGNITY
OF INVENTION**

It has been demonstrated elsewhere in this brief that Stallman was a late comer in the bearing art. Others before him (notably Heim, Kempster and Zahn) had devised bearings consisting of outer and inner races with rollers (and even needles, as in Heim) having reduced neck portions intermediate their ends and with guide ribs or rings fitting into the reduced portions of the rollers to present endwise motion of the rollers or to maintain the rollers in position. Further, and as the District Court correctly observed (Tr. p. 32), the prior art reveals both a bearing with the central guide rib on the outer race and a bearing with the guide rib on the inner race, and either

type of these bearings could be appropriately employed in applications in which the race having the guide rib would be stationary.

Appellant fully recognized that such could be the case since he declared (Tr. Vol. II, p. 288, Col. 2, lines 51-62):

“The invention as herein disclosed is applied to a bearing having both an inner and an outer race. It is customary to manufacture bearings with an outer race only to run on a shaft which takes the place of the inner race, and also to manufacture bearings with an inner race only, with the inner periphery of a gear or pulley hub serving as the outer race. The present invention is adaptable to these uses as is apparent from the foregoing description and drawing and wherever the term “race” is used herein, it is intended to include any surface on which the rollers operate.”

The uncontroverted evidence adduced by the defendant was that satisfactory bearing operation was obtained in a substantial number of installations irrespective of whether the guide rib or rail was on the stationary or upon the rotating race of the bearing installation (Tr. Vol. I, pp. 124-132).

Against this backdrop appellant contends that he was the first to recognize that the old devices of the art “had a theretofore unperceived advantage which would be realized in some old and common applications, but not in others” (Tr. Vol. I, p. 33). Even assuming, *arguendo*, that this was true, it is settled law that mere perception of such advantages does not in and of itself constitute invention. This Court, in *Cutter Laboratories, Inc. v. Lyophile-Cryochem Corp.* 179 F(2d) 80, 84 USPQ 54, so held. In the *Cutter* case the jury had, *inter alia*, brought in a verdict sustaining the validity of Claim 6 of the Reichel patent. This Court

held that claim invalid for lack of invention over the prior art saying:

“Where a process has been fully disclosed in the prior art without full appreciation of all its valuable attributes, the perception of new advantages in the old process does not in itself constitute invention. *General Electric Co. v. Jewell Incandescent Lamp Co.*, 326, U.S. 242, 247-249 (67 USPQ 155, 157-158) (1945); *Celite Corp. v. Dicalite Co.*, 96 F. 2d 242, 248 (37 USPQ 383, 388-389).”

This same principle had previously been applied by the Supreme Court of the United States in a mechanical patent case, namely, *General Electric Co. v. Jewel Incandescent Lamp Co.* 326 U.S. 242, 248, saying:

“The principle of the *Ansonia* case plainly would deny validity to the Pipkin patent if the prior art disclosed an electric bulb so frosted on the inside as to round out the angular crevices produced by the first etching, *whether the full utility of the bulb had been previously recognized or not*. The same result is indicated where, as in the present case, the prior art discloses the method of making an article having the characteristics of the patented product, *though all the advantageous properties of the product had not been fully appreciated.*” (Emphasis supplied.)

This Court applied this same principle in *Kalich v. Paterson Pacific Parchment Co.* 137 F(2d) 649, 58 USPQ 637, 640, with this statement:

“Skill by one of the trade rather than invention was involved in the solution here. Patentees are not entitled to a monopoly for the judicious use of materials the use of which would produce the result to be expected from such selection. Recognition is not invention. *Continental Fibre Company v. Formica Insulation Company*, 287 F. 455; *Vitamin Technologists, Inc.*,

a Corporation v. Wisconsin Alumni Research foundation, 9 Cir. 136 F. 2d 318 (58 USPQ 293); Aero Neck-Band & Collar Company v. Beaver Mfg. Co., 97 F. 2d 363, 365 (38 USPQ 153, 155)."

Equally declarative of the invalidity of patents like the Stallman claims in suit, insofar as they purport to confer a monopoly on Appellant for his work in re-dimensioning and reportioning of the prior art bearings, was the following language in the *Kalich* case (58 USPQ 640):

"There is the old rule that one is not entitled to a patent who merely makes a change in form, proportion or degree, by substantially the same means even though the changes he makes produce better results. *Burt v. Ivory*, 133 U.S. 349; *Market Street Railway Co. v. Rowley*, 155 U.S. 621; *In re Prescott, et al.*, 49 F. 2d 825 (9 USPQ 236); *Monckmeier v. Erie Mfg. Co.*, 98 F. 2d 369, 371 (38 USPQ 200, 203); *Wagner v. Meccano, Ltd.*, 246 F. 603, 608 and citations."

It follows then that the District Court was justified in refusing to find validity in Appellant's patent when to the Court it represented, at best, mere *recognition* of claimed existing, but unperceived advantages in old bearing structures.

APPELLANT'S PATENT IS ALSO INVALID FOR FAILURE TO DESCRIBE AND CLAIM THE ALLEGED INVENTION WITH THE DETAIL AND PARTICULARITY REQUIRED BY THE PATENT STATUTES.

Among the grounds urged in support of Appellee's Motion for Judgment Notwithstanding Verdict was the proposition that the Stallman patent specification and claims do not describe and claim the alleged invention with the particularity required by the patent statutes (Tr. Vol. I, p. 15 (Item 1) pp. 19-20, Items 3(c) and 3(c)(1). The District Court, while recognizing merit in these contentions, did not

reach them in view of its conclusion that Appellant's patent is invalid for lack of invention (Tr. Vol. I, pp. 31-32).

This proposition is again urged as an added ground for affirmance of the judgment n.o.v. since it also spells out invalidity of the patent in suit.

Appellant's Opening Brief (pp. 4 and 6) purports to describe the Stallman invention, but it is significant that the patent itself is not cited or called upon to substantiate the description. The reason is plain. The Stallman patent does *not* contain a description in its specification matching or even supporting the characterization given in the brief.

Thus the assertion (Brief p. 4) that Stallman "invented the solution for this long vexing problem by providing a guide ring or rail on the *stationary* race of the bearing", is not borne out by the patent specification (Tr. Vol. II, pp. 287-288) which is devoid of criticality in the placement of the guide ring or rib on the stationary race. On the contrary, Stallman merely states a *preference* for such placement of the guide rib or ring (Tr. Vol. II, p. 288, Col. 1, lines 26-32) without explaining why this is so. Similarly, the idea of *space* to "permit *skewing* of the roller when subjected to unbalanced forces", the correction of "*skewing*" and the prevention of "the locking of such bearing as a result of excessive *skewing*", set forth in appellant's Opening Brief (p. 4) are figments of the imagination of the patentee long after the grant, since there is not one single reference to skewing or the so-called use of "skewing forces" in the specification of the Letters Patent in suit. Stallman instead speaks of "misalignment" and how he thought it was corrected (Tr. Vol. II. page 288, column 2, lines 7-50), but in so doing he was unwittingly, or otherwise restating the teachings clearly set forth in the British patent to Zahn (Tr. Vol. II, 292, lines 19-34 and Fig. 1).

True enough, the Stallman patent drawings show spaces between the parts, but similar spaces which would permit skewing of the roller are provided in the prior art patents hereinabove discussed or could be provided therein through the exercise of mere mechanical skill, and in this particular the Stallman device may not be and is not distinguished from those teachings.

The description attempted at pp. 6-7 of Appellant's Brief is equally at variance with the meager recitals of the patent specification.

In these respects the specification of the Stallman patent *failed* to contain the:

“ * * * written description of the invention, and the manner and process of making it, in such full, clear, concise, and exact terms * * *

and it failed also to:

“ * * * set forth the best mode contemplated by the inventor of carrying out his invention. * * * ”

as required by 35 U.S.C. §112.

Instead, the specification merely sets forth a general description of the parts of the several species of bearings (i.e., Fig. 1 wherein the guide rib is a ring 15 inserted into the outer race 10 and having a portion projecting into the reduced neck 14 of the roller 12; Fig. 2 wherein the ring 15 is inserted in the inner race 11; Fig. 4 wherein the guide rib 18 is integral with the outer race 10 and Fig. 5 wherein two guide ribs 20 are integral with the outer race).

From this the specification progresses to a brief discussion (Tr. Vol. II, p. 288, Col. 2, lines 30-50) of misalignment of one of the rollers 12 shown in Fig. 7 and a prophetic statement concerning the “tendency” of such misaligned bearing.

But nowhere in the specification of Stallman is there a detailed description or statement of why or how it is that the placement of the guide rib or rail on the stationary race or bearing member contributes in any fashion to the correction of misalignment of the rollers. Nor does the specification set forth that the relative dimensioning of parts or the clearances for parts contribute in any way to the accomplishment of the purpose now claimed for the invention. Thus the Stallman specification might well be taken as a description of the prior art devices of Heim, Kempster or Zahn and in that sense it fails to comply with the Statute.

Moreover, the claims of the patent do not and, of course, cannot cure this fatal defect in the Stallman specification. It is true that Claims 1 to 8, inclusive, specify the placement of the guide rib or ring on the stationary race, but this characterizing language was added to the claims by amendment during prosecution of the application. This was obviously "new matter" unsupported by the specification or a new oath. But the claims, like the specification, do not allude to the asserted skewing correction function of the central guide rib or that this function depends upon the placement on the race which will be stationary when the bearing is in operation.

Appellant's patent is, for these reasons, doubly vulnerable to invalidation for failure to comply with 35 U.S.C. 112, since the presently asserted "invention" finds no antecedent in either the specifications or the claims of the patent. Hence Appellant is far worse off than was the patentee in *Winslow Engineering Company v. Leroy R. Smith*, *supra*, for there the specification described the invention but it was not defined in the claims. It will be remembered that in the cited case this Court found invention present in the Oil Filter, but regarded *Graver Mfg. Co.*

v. Linde, 336 U.S. 271, 277, as compelling it to hold the claims invalid for failure to satisfy the old statute (35 U.S.C. 33) or the new (35 U.S.C. 112) and the latter because the patent did not conclude with claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention".

It is respectfully submitted that the underlying rule of the *Winslow* case is equally applicable to the patent in suit.

McGILL IS NOT A PARTY TO THE ACTION

As noted in the opening portion of this brief, McGill Manufacturing Company is not a party to this controversy, the action having been dismissed as to it by Order of August 9, 1954.

It is, therefore, somewhat surprising to see that Appellant has devoted a considerable portion of his Factual Statement (Opening Brief pp. 4-5) to what McGill did or did not do. One can only surmise that the recitals are for the purpose of leading the reader to ponder whether McGill was guilty of some inequitable conduct toward Appellant. If that was the purpose, it need only be noted that when the full record is examined it will reveal that McGill acted in a perfectly straightforward manner toward Stallman in its dealings, terminating them when its patent counsel advised that the patent was, as the District Court subsequently held, invalid.

If on the other hand, the recitals are to be the basis of an argument that there has been some commercial success with the Stallman bearing through the efforts of McGill, then the Court need only be reminded that no showing of commercial success, in whatever degree, will vitalize a clearly invalid patent. It cannot fill the void where invention is plainly lacking.

Jungerson v. Ostby & Barton Co., 335 US 560, 80 USPQ 32;

Fernandez v. Phillips, 136 F(2d) 404, 58 USPQ 47 (CA 9);

Photochart v. Photo Patrol, Inc., 189 F(2d) 625, 90 USPQ 46.

CONCLUSION

The conclusion of the Court below as to invalidity of the patent in suit was based upon a record demonstrating lack of patentability in the subject matter beyond any reasonable doubt. The record contained not only the patent in suit, the prior art patents cited by the Patent Office during prosecution of the Stallman application, but additional, pertinent prior patents that were *not* cited during such prosecution and the patentee's own characterization of his concept, recited in such terms and with such definiteness as to make a finding of invalidity inescapable.

It being the "right and duty" of the trial judge to enter a judgment n.o.v. where it appears there is a clear-cut case of lack of invention, it is abundantly clear that this was an appropriate case for the exercise of this power.

It is respectfully submitted that the judgment should be affirmed.

Respectfully submitted,

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